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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Orincon Industries, Inc.

Serial No. 76259604

John M. Kim of Gray Cary Ware & Freidenrich for Orincon Industries, Inc.

Anne Madden, Trademark Examining Attorney, Law Office 103
(Michael Hamilton, Managing Attorney).

Before Hairston, Chapman and Bucher, Administrative
Trademark Judges.

Opinion by Chapman, Administrative Trademark Judge:

The application involved herein was filed on May 18, 2001, by Orincon Industries, Inc. (a California corporation) to register on the Principal Register the mark TRAC SYSTEM for goods and services ultimately identified as follows:

"integrated hardware and software components consisting of an inductive loop detector, an inductive loop signal analyzer, a local controller, a central processing unit with a portal to the Internet, a telephone, fiber optic, or wireless communications interface, and

traffic management software for analyzing signals from inductive loops to determine the identification, speed, and location of vehicles, tracking the position of vehicles, and providing access to traffic statistics" in International Class 9;

"maintenance of computer hardware" in International Class 37; and

"leasing of computers, computer hardware and computer software and maintenance of computer software" in International Class 42.

The Examining Attorney has made final her refusal of registration under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), on the ground that applicant's mark, TRAC SYSTEM, when used on applicant's International Class 9 goods, is merely descriptive thereof.¹

Applicant appealed, and both applicant and the Examining Attorney have filed briefs. Applicant did not request an oral hearing.

Essentially, the Examining Attorney's position is that the term "TRAC" is the phonetic equivalent of "track," which is defined as "awareness of something occurring or passing" in The American Heritage Dictionary (Third Edition 1992) and (also in that dictionary) "tracking" is a

¹ The Examining Attorney initially refused registration under Section 2(e)(1) as to all three classes of goods and services, but she withdrew the refusal as to the two classes of services in the final Office action dated May 13, 2002.

transitive verb based on the verb "track"; that the term "SYSTEM," is defined as "1. A group of related components that interact to perform a task. ..." in the Tech Encyclopedia,² and "is generic for computer goods" (brief, p. 4); that the combination of the two descriptive words does not create a new non-descriptive commercial impression; and that the applied-for mark is "merely descriptive of a feature of the [identified] goods, which are a computer system comprised of hardware and software used to manage traffic and track the location of vehicles and access traffic statistics" (brief, p. 4). The Examining Attorney argues that applicant's computer hardware and software systems "will be sold to sophisticated purchasers such as traffic planners and traffic managers" (brief, p. 5); and that "the purchasers are specialists in the traffic management field who will know immediately that the goods are used to observe and track traffic and traffic patterns" (brief, p. 6).

In support of this position, the Examining Attorney submitted the definitions referred to above; photocopies of several third-party registrations in which the term "track" is disclaimed; photocopies of several excerpted articles

² The Examining Attorney's request that the Board take judicial notice of the definition of the word "system" is granted.

retrieved from the Nexis database which refer to tracking software; and printouts of a page from applicant's web site showing that applicant refers to its "system" which, inter alia, "tracks vehicles."

Applicant essentially contends that, as shown on its web site, the term "TRAC" does not relate to "track" but instead is an acronym for "Traffic Reporting And Control"; that a multi-step process and a degree of imagination and thought is involved in order for relevant purchasers to understand applicant's goods ("integrated hardware and software components" including "traffic management software"); that the mark does not "immediately" convey direct information regarding applicant's goods; that applicant's mark is suggestive rather than merely descriptive; and that any doubt as to the question of whether a mark is merely descriptive should be resolved in applicant's favor. Applicant submitted printouts of two pages from its web site.

It is well settled that "a term is descriptive if it forthwith conveys an immediate idea of the ingredients, qualities or characteristics of the goods [or services]." (Emphasis added). In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978). Moreover, the immediate idea must be conveyed with a "degree of

particularity." In re TMS Corporation of the Americas, 200 USPQ 57, 59 (TTAB 1978). See also, See In re Nett Designs, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001); and In re Entenmann's Inc., 15 USPQ2d 1750, 1751 (TTAB 1990), aff'd, unpub'd, Fed. Cir. February 13, 1991.

Further, it is well-established that the determination of mere descriptiveness must be made not in the abstract or on the basis of guesswork, but in relation to the goods or services for which registration is sought, the context in which the term (or phrase) is being used or is intended to be used on or in connection with those goods or services, and the impact that it is likely to make on the average purchaser of such goods or services. See In re Omaha National Corp., 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987); In re Abcor, 200 USPQ at 218; and In re Pennzoil Products Co., 20 USPQ2d 1753 (TTAB 1991).

It has long been acknowledged that there is often a very narrow line between terms which are merely descriptive and those which are suggestive, and the borderline between the two is hardly a clear one. See In re Atavio Inc., 25 USPQ2d 1361 (TTAB 1992).

Viewing this record in its entirety, we find that the evidence submitted by the Examining Attorney does not establish a prima facie case that the mark TRAC SYSTEM is

merely descriptive of applicant's identified goods, "integrated hardware and software components consisting of an inductive loop detector, an inductive loop signal analyzer, a local controller, a central processing unit with a portal to the Internet, a telephone, fiber optic, or wireless communications interface, and traffic management software for analyzing signals from inductive loops to determine the identification, speed, and location of vehicles, tracking the position of vehicles, and providing access to traffic statistics."

As to the relevant purchasers (or users) of these goods, the Examining Attorney has stated that the purchasers (or, perhaps more accurately, the users) of applicant's goods are traffic planners and traffic managers, and they are specialists who are sophisticated purchasers/users. Applicant's web site includes information on this point, for example, "ORINCON's technology accomplishes all this by using inductive loops already embedded in roads and highways in most industrialized nations. ... ORINCON takes these loops to their full potential with TRAC and Traffic Reporter." We find that the relevant purchasers of the goods are governmental entities, and the users are traffic planners and traffic managers.

None of the excerpted stories retrieved from the Nexis database show use of the words "TRAC SYSTEM"; and the fact that various companies utilize some type of computer program to track inventory or assets or vehicles, etc. does not establish that the words "TRAC SYSTEM" immediately and forthwith describe a significant feature of applicant's integrated hardware and software components to the relevant purchasers and users. Rather, purchasers and users would have to exercise a multi-stage reasoning process to determine any specific descriptive meaning of TRAC SYSTEM in relation to applicant's goods--first perceiving "trac" to be the phonetic equivalent of "track" and then ascertaining that applicant's integrated hardware and software components identify and track traffic and/or vehicles. See *In re Sundown Technology Inc.*, 1 USPQ2d 1927 (TTAB 1986); and *In re Tennis in the Round Inc.*, 199 USPQ 496 (TTAB 1978).

In sum, the record before us does not establish that the term TRAC SYSTEM has a merely descriptive meaning readily recognized by the relevant purchasers/users with regard to the identified goods. See *Concurrent Technologies Inc. v. Concurrent Technologies Corp.*, 12 USPQ2d 1054 (TTAB 1989); *In re Intelligent Medical Systems Inc.*, 5 USPQ2d 1674 (TTAB 1987); and *In re TMS Corporation*

of the Americas, supra. That is, the mark TRAC SYSTEM does not immediately evoke an impression or an understanding of a feature and/or purpose of applicant's integrated hardware and software components. Rather, we conclude that the mark TRAC SYSTEM requires several steps of thought to determine any significant feature and/or purpose therefrom.

Moreover, competitors would still be free to utilize the words "tracking system" in a non-trademark manner.

Finally, if doubt exists as to whether a term is merely descriptive, as it does in this case, it is the practice of this Board to resolve doubt in favor of the applicant. See *In re The Stroh Brewery Co.*, 34 USPQ2d 1796 (TTAB 1995). In this way, anyone who believes that the term is, in fact, descriptive, may oppose and present evidence in an inter partes proceeding on this issue to the Board.

Decision: The refusal to register the mark for the International Class 9 goods as merely descriptive under Section 2(e)(1) is reversed. (The application will proceed to publication for opposition in International Classes 9, 37 and 42.)